IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Doreen Lynn Galli

Examiner: Kang, Insun

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Docket No. **RSW920010033US1**

For: **METHOD AND APPARATUS FOR TAILORING VOICE PROMPTS OF AN INTERACTIVE VOICE RESPONSE SYSTEM**

Commissioner for Patents
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REPLY BRIEF OF APPELLANT

This Reply Brief is in reply to the Examiner's Answer filed February 1, 2010 and includes responses to all pertinent arguments in the Examiner's Answer, including responses to new arguments in the Examiner's Answer that did not appear in the Final Office Action mailed November 12, 2008.

GROUND OF REJECTION 1

Claims 9 and 18-20 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

Claim 9

Appellant respectfully contends that Osder does not anticipate claim 9, because Osder does not teach each and every feature of claim 9 as evidence in the following two examples.

As a first example of why Osder does not anticipate claim 9, Osder does not teach the feature: "receiving commands from a telephone caller; responsive to said received commands, determining that the voice prompt is needed; responsive to said determining that voice prompt is needed, providing a variable identified with a function of the voice prompt" (emphasis).

Appellant asserts that Osder does not teach that a command is received from a telephone caller, which results in determining that the voice prompt is needed.

Appellant asserts that the only appearance of "caller" in Osder is in Osder, col. 28, lines 1-7 which recites: "The SYSTEM Indexed Prompt Table contains prompt names for the prompts required by PEP 13 for handling certain error conditions, providing a standard greeting for a Network Application, providing the voice, beep or tone that notifies a caller to begin recording a message and providing a prompt that plays one second of silence after another prompt is played.". Appellant asserts that the preceding quote from Osder does not teach receiving commands from the caller, but rather notifies the caller to begin recording a message.

Appellant notes that Osder sometimes uses the word "user" to represent a telephone caller. All such references to "user" as a telephone caller in Osder are as follows.

Osder, col. 9, lines 54-58 recites: "a user effects a telephone connection with SPIN 12 via telephone 45 with respect to the user's session of terminal 42 and SPIN 12 prompts the user through the prompt management procedure." Appellant asserts that the preceding quote from Osder does not teach receiving commands from the user.

Osder, col. 17, lines 13-14 recites: " The SPIN User ID is entered to uniquely identify a user in establishing a telephone connection to SPIN." Appellant asserts that the preceding quote from Osder does not teach receiving commands from the user.

Osder, col. 18, lines 5-12 recites: "As described with respect to FIG. 8, the SPIN User ID is displayed on the bottom of the screen and the OFFLINE/ONLINE field displays whether or not the telephone 45 is connected to the SPIN terminal session. SPIN 12 communicates with Expand Prompts 60, via the path 78, to play prompts to the user through the telephone 45 for controlling the recording or playing of voice." Appellant asserts that the preceding quote from Osder does not teach receiving commands from the user.

The Examiner's Answer, page 3, lines 14-16 argues that Osder, col. 8, lines 1-7 teaches the preceding feature of claim 9.

In response, Appellant respectfully contends that Osder, col. 8, lines 1-7 teaches receiving "voice messages from a telephone connection", but does not teach that the voice messages received from the telephone connection are commands from a telephone caller. For example, a voice message from a telephone caller may be "hello" which is not a command, "am I properly connected?" which is not a command, etc. To the contrary, Osder, col. 7, lines 67 teaches that commands are received from software, namely through Application Interface Module (AIM) 30.

Further to the contrary, Osder, col. 12, lines 1-6 recites: "With continued reference to FIG. 4, a Network Application 10 uses PEP commands to request the playing of prompts and to supply any dynamic data required by a prompt. A PEP command from a Network Application 10 is intercepted by the agent 16 and passed to PEP 13 along a path 61 for expansion." The preceding quote from Osder discloses that the agent 16 receives PEP commands from the Network Application 10, rather than from the user, for playing prompts.

Furthermore, Osder, col. 28, lines 1-7 recites: "The SYSTEM Indexed Prompt Table contains prompt names for the prompts required by PEP 13 for ... providing the voice, beep or tone that notifies a caller to begin recording a message". In other words, Osder teaches the software directing a command to the telephone caller ("notifies a caller to begin recording a message") and not vice versa.

The Examiner's Answer, page 3, lines 13-19 further argues that "Osder discloses ... responsive to said received commands, determining that the voice prompt is needed (i.e. "When a Network Application 10 requires that a prompt to be played," col. 7 lines 41-42)".

In response, Appellant notes that the preceding quote of Osder in the Examiner's Answer is incomplete and hence misleading. The complete quote from Osder, col. 7, lines 41-43 is: "When a Network Application 10 requires that a prompt be played, the Network Application issues a PEP command to the agent 16."

In other words, claim 9 requires that the voice prompt is responsive to the commands received from the telephone caller. In contrast, Osder, col. 7, lines 41-43 teaches that the PEP command is responsive to a determination by the Network Application 10 that a voice prompt is needed.

In "Response to Arguments", the Examiner's Answer, page 10, lines 15-19 argues: "In response, it is noted that the only location where the term, "commands" is mentioned is on page 6, line 20 of the specification: "the processor 100 executes the application program 110 according to call flow instructions responsive to the needs and commands of a telephone caller." Based on this broad description of the term, the commands can be any caller inputs that instruct the voice prompt system to function and ultimately play the prompts over the telephone."

In response, Appellant acknowledge that the commands can be any caller inputs that instruct the voice prompt system to function. However, the Examiner's Answer has not cited anything in Osder allegedly teaching instructing the voice prompt system to function. Therefore, the preceding argument in the Examiner's Answer does not demonstrate a teaching in Osder of receiving commands from the user.

In "Response to Arguments", the Examiner's Answer, page 11, lines 1-12 argues: "Osder discloses a new prompt management system providing multiple spoken languages support without altering the functional code of the Network Application containing call flow and isolating the customization of the spoken prompts from the call flow and programmatic logic of the Network Application (Osder, col. 27 lines 27-41) by using SPIN that is used "on behalf of a Network Application to create or modify the prompts and the elements of the prompts to be played by the Network Application in a predetermined spoken language (Osder, col. 3 lines 48-51)." The "Network Applications Platform (NAP) ...with respect to the prompt management system" of Osder (col. 1 lines 1-11) contains telephone network functionality actuatable by commands from supported Network Applications, such as commands controlling answering a

telephone call, initiating a telephone call, and playing a voice message over an established telephone connection (col. 1 lines 13-20).""

In response, Appellant note that the "commands" referred to in the preceding quote from Osder, col. 1, lines 13-20 are received from supported Network Applications and not from the user. Therefore, the preceding argument in the Examiner's Answer does not demonstrate a teaching in Osder of receiving commands from the user.

In "Response to Arguments", the Examiner's Answer, page 11, line 12 - page 12, line 12 argues: "Just as the appellant acknowledges, in Osder, the "user effects a telephone connection with SPIN 12 via telephone 45 with respect to the user's session of terminal 42 and **SPIN 12 prompts the user through the prompt management procedure (brief, 7, lines 1-4)."** The "connection of the telephone 45 to NAP 11 may be effected by dialing the telephone number of the SPIN assigned port and entering the SPIN User ID on the telephone keypad (col. 17 lines 52-65)." Thereafter "SPIN communicates with Expand Prompts 60, via the path 78, to play prompts to the user through the telephone 45 for controlling the recording or playing of voice (col. 18 lines 1-13)." The SPIN USER ID is a unique identifier of a user who calls in to SPIN for voice recording and play-back where a "telephone is used to record and play voice for the prompts and elements of the SPIN applications via NAP 11 (col. 16 lines 47-49)." For example, when SPIN prompts the user to enter a user option through the prompt management procedure after the caller effects the telephone connection with SPIN 12, ***the user's selection in response to the SPIN prompt, for example, of recording a voice prompt is a user command for recording***." In connection to the recording option presented to the caller over telephone, "The Record now?" field is used to control the session during which voice for the element will be

recorded. To record voice when the element is created, "Y" is entered (col. 18 lines 44-47)." When a "Network Application 10 requires that a prompt to be played (i.e. col. 7 lines 41-42)," in response to the caller commands including dialing, entering the SPIN User ID, and responding to the SPIN prompts through the prompt management procedure, the SPIN application table that assigns the values of the IDs to point to the prompt element sets such as the tables 2-5 containing the pre-recorded prompts in SPINDB as seen in Fig 3 is accessed. ***The particular Network Application, SPIN, and PEP commands are generated based on the caller/user commands (user prompts through the prompt management procedure).***"(bold italics emphasis added)

In response, Appellant notes that the preceding argument in the Examiner's Answer is relying on a voice prompt recording and editing process described in Osder, col. 18, line 13 - col. 19, line 15 in conjunction with the element processing screen (ELE) 250 in Osder, FIG. 11. In particular, the Examiner's Answer is alleging that the user's responses to queries (e.g., "RECORD NOW?") in the ELE 250 as being user "commands". Appellant asserts that the inputs received from the user in response to the queries presented to the user during the recording and editing process are not commands.

However, even if the inputs received from the user in response to the queries presented to the user during the recording and editing process are commands, such input received from the user during the recording and editing process cannot be the "commands" recited in claim 9. In particular, if the inputs (alleged to be "commands") received from the user are the user's responses to queries during the recording and editing process, then Osder does not teach the limitations of "responsive to said received commands, determining that the voice prompt is needed; responsive to said determining that voice prompt is needed, providing a variable identified with a function of the voice prompt". Appellant asserts that the inputs received from

the user during the recording and editing process do not trigger performance of "determining that the voice prompt is needed" and "providing a variable identified with a function of the voice prompt" responsively in sequence, as required by the preceding limitations of claim 9.

For example, receiving the user edit of "Y" for the "RECORD NOW?" example triggers recording voice for the element 251 in Osder FIG. 11, as stated in Osder, col. 18, lines 45-47 ("The "Record now?" field is used to control the session during which voice for the element will be recorded. To record voice when the element is created, "Y" is entered."). Thus for the "RECORD NOW?" example, Osder merely teaches a response of recording voice and does not teach the "limitation of "responsive to said received commands, determining that the voice prompt is needed; responsive to said determining that voice prompt is needed, providing a variable identified with a function of the voice prompt".

In further support of Appellant's argument, Appellant notes that the Examiner's Answer does not even allege that the step of "determining that the voice prompt is needed" is performed in response to receiving command from the user if the commands are the inputs received from the user during the recording and editing process described in Osder, col. 18, line 13 - col. 19, line 15. To the contrary, the Examiner's Answer, page 3, lines 13-19 argues: "Osder discloses ... responsive to said received commands, determining that the voice prompt is needed (i.e. "When a Network Application 10 requires that a prompt to be played," col. 7 lines 41-42)". Thus, the Examiner's Answer argues that the step of "determining that the voice prompt is needed" is performed during playback of a prompt and therefore not in response to inputs received from the user during the recording and editing process. Accordingly, the Examiner's arguments are inconsistent with respect to the limitation of "determining that the voice prompt is needed" being

performed in response to receiving commands from the user, wherein the commands are user input during the recording and editing process.

In further support of Appellant's argument, Appellant notes that the Examiner's Answer does not even allege that the step of "providing a variable identified with a function of the voice prompt" is in response to determining that voice prompt is needed, which is in response to receiving commands from the user. In particular, the Examiner's Answer, page 3, line 20 - page 4, line 2 argues that Osder teaches "providing a variable identified with a function of the voice prompt" but does not even address the requirement that "providing a variable identified with a function of the voice prompt" must be performed in response to determining that voice prompt is needed, which is in response to receiving commands from the user. Accordingly, the Examiner's arguments are inconsistent with respect to the limitation of "providing a variable identified with a function of the voice prompt" being performed in response to determining that voice prompt is needed, which is performed in response to receiving commands from the user, wherein the commands are user input during the recording and editing process.

The Examiner's Answer, page 13, line 21 - page 14, line 3 argues: "In response, as addressed above, the only portion in the whole specification (page 1-10) that mentions "commands" and describes the corresponding above limitations are: " the processor 100 executes the application program 110 according to call flow instructions responsive to the needs and commands of a telephone caller...when a voice prompt is needed, the application program provides a metalanguage variable that identifies the function of the voice prompt" on pages 6-7. However, ***according to the applicant, this is "irrelevant" to the claim.***" (emphasis added).

In response, Appellant asserts that the preceding argument in the Examiner's Answer does not correctly state Appellant's argument in the last paragraph on page 10 of Appellant's Appeal Brief, which recites: "In response to the preceding argument in the Examiner in "Response to Arguments ", Appellant asserts that ***the Examiner's statement*** that Appellant's specification recites "when a voice prompt is needed, the application program provides a metalanguage variable that identifies the function of the voice prompt" ***is irrelevant to the preceding feature of claim 9***. The preceding feature of claim 9 recites "responsive to said received commands, determining that the voice prompt is needed", which is not addressed in the preceding argument by the Examiner in "Response to Arguments"."

In other words, Appellant's argument in the last paragraph on page 10 of Appellant's Appeal Brief argues that "the Examiner's statement ... is irrelevant to the preceding feature of claim 9". Thus, what is stated to be irrelevant is the Examiner's statement. The last paragraph on page 10 of Appellant's Appeal Brief does not state that "when a voice prompt is needed, the application program provides a metalanguage variable that identifies the function of the voice prompt" is irrelevant to claim 9.

In summary, Appellant has presented and analyzed every referral to "caller" and every referral to "user" in which the user represents a telephone caller, and Appellant has demonstrated that in every such referral to "caller" and "user", Osder does not teach that a command is received from a telephone caller which results in determining that the voice prompt is needed, which results in providing a variable identified with a function of the voice prompt.

In addition, Appellant has demonstrated that every citation to Osder by the Examiner's Answer with respect to the preceding feature of claim 9 does not teach that a command is

received from a telephone caller which results in determining that the voice prompt is needed, which results in providing a variable identified with a function of the voice prompt.

Therefore, Osder does not anticipate claim 9.

As a second example of why Osder does not anticipate claim 9, Osder does not teach the feature:

"identifying a first database record that includes a digitally encoded voice prompt consisting of a first bit pattern that consists of a first sequence of bits, wherein the bits of the first sequence of bits are stored contiguously in the identified first database record, and wherein said identifying the first database record is implemented through use of the first value which selects the first database record and specifies the first bit pattern;

performing a first process that generates a first complete message from the identified first database record and speaks the generated first complete message to the telephone caller, said performing the first process consisting of the steps of:

reading the identified first database record;

passing the first bit pattern from the first database record that had been read to an audio apparatus;

performing, by the audio apparatus, a digital-to-analog conversion of the first bit pattern that had been passed to the audio apparatus;

speaking, by the audio apparatus, the first complete message to the telephone caller, said first complete message consisting of the digital-to-analog converted first bit pattern."

The preceding claimed first process ***consists of*** four steps (reading, passing, performing, speaking) having linkage requirements with respect to performance order and data coupling, due to the recited linking language, as explained *infra*.

The linking language of "the first database record that had been read" in the "passing" step generates the linking requirements of: (1) the "passing" step must be performed after the

"reading" step; and (2) the same first bit pattern that is read from the first database record in the "reading" step is passed to the audio apparatus in the "passing" step. The Examiner's Answer has not demonstrated that Osder satisfies the preceding linking requirements that link the "reading" and "passing" steps.

For the reading step, the Examiner's Answer, page 4, lines 8-14 cites Osder, col. 28, lines 30-37; col. 3, lines 48-60; col. 12, lines 59-61; col. 10, lines 6-10, which does not even disclose the "reading" step of reading the identified first database record. For the "passing" step, the Examiner's Answer, page 4, lines 18-20 cites Osder, col. 3, lines 48-61; col. 4, lines 5-25; col. 6, lines 11-31, which discloses "a NAP Send Voice Message command to play the prompt over the telephone" in Osder, col. 4, lines 18-19. However, the bit pattern of the prompt that must be passed to an audio apparatus in the "passing" step after performance the "reading" step is not a bit pattern appearing in any of the citations in the Examiner's Answer for the "reading" step. As explained *supra*, the citations in the Examiner's Answer do not even teach the "reading" step.

The linking language of "the first bit pattern that had been passed to the audio apparatus" in the "performing" step generates the linking requirements of: (1) the "performing" step must be performed after the "passing" step; and (2) the bit pattern that is converted in the digital-to-analog conversion of the "performing" step must be the same bit pattern that had been previously passed to the audio apparatus in the "passing" step. The Examiner's Answer has not demonstrated that Osder satisfies the preceding linking requirements that link the "passing" and "performing" steps. For the "passing" step, the Examiner's Answer, page 4, lines 18-20 cites Osder, col. 3, lines 48-61; col. 4, lines 5-25; col. 6, lines 11-31, which discloses "a NAP Send Voice Message command to play the prompt over the telephone" in Osder, col. 4, lines 18-19. For the "performing" step, the Examiner's Answer, page 4, lines 21-23 cites Osder, col. 5, lines

42-56, which does not even teach performing the recited digital-to-analog conversion. Therefore, the bit pattern that is required to be converted by a digital-to-analog conversion in the "performing" step after execution of the "passing" step is not the bit pattern that was passed to the audio device in the "passing" step. As explained *supra*, the citation in the Examiner's Answer does not even teach the "performing" step.

The linking language of "consisting of the digital-to-analog converted first bit pattern" in the "speaking" step generates the linking requirements of: (1) the "speaking" step must be performed after the "performing" step; and (2) the bit pattern of the message that is spoken in the "speaking" step has been previously converted in the digital-to-analog conversion of the "performing" step. The Examiner's Answer has not demonstrated that Osder satisfies the preceding linking requirements that link the "performing" and "speaking" steps. For the "performing" step, the Examiner's Answer, page 4, lines 21-23 cites Osder, col. 5, lines 42-56, which does not even teach performing the recited digital-to-analog conversion. For the "speaking" step, the Examiner's Answer, page 4, lines 24-25 cites Osder, col. 5, lines 42-56, which recites: "If there were five new messages in the mailbox at run time, the prompt would play "you have five new messages"" in Osder, col. 5, lines 54-56. However, the bit pattern of the message that is spoken in the "speaking" step in Osder, col. 5, lines 54-56 has not been converted in a prior digital-to-analog conversion in the citation in the Examiner's Answer for the "performing" step. As explained *supra*, the citation in the Examiner's Answer does not even teach the "performing" step.

In summary, the citations in the Examiner's Answer for the four steps (reading, passing, performing, speaking) in the recited first process do not satisfy the aforementioned linkage

requirements with respect to performance order and data coupling. Thus, Osder does not anticipate claim 9.

In "Response to Arguments", the Examiner's Answer, page 14, line 15 - page 15, line 14 responds the Appellant's preceding argument regarding the aforementioned linkage requirements with respect to performance order and data coupling, by reciting:

"In response, despite of the overstated claim language, the plain meaning of the reading and passing steps from the specification is referenced for claim interpretation. According to the specification including the original claims, when "a voice prompt is needed, the application program 110 provides a metalanguage variable that identifies the function of the voice prompt...The assignment table 120 is then accessed in accord with the variable, thereby to assign a specific value to the variable...The database 130 of pre-recorded voice prompts is accessed at the entry point specified by the specific value of the variable...and the desired voice prompt, which is held in the database 130 as a digitally encoded audio signal, is read from the database. The voice prompt is passed to the audio appartus 140, which provides the necessary digital-to-analog conversion of the voice prompt, and speak voice the prompt to the telephone caller(specification page 7 lines 1-10)."

As previously stated, Osder's SPIN application table assigns the value of the SPIN application ID variable, which is the identifier for a specific language (metalanguage variable). For example, the value UV 10AE is to identify the American English prompt record (Osder, Fig.3). The SPIN application ID is the Network Application's sole awareness of the languages that it supports and of the pre-recorded voice elements with which it speaks these languages," Osder, col. 28 lines 30-40). The desired American English prompt based on UV 10AE is read

from the SPIN database (SPINDB) storing digitized voice prompts (i.e. col. 3 lines 55-57; col. 28 lines 55-61) and passed to the Network Application to play/speak the American English prompt "in requests to play prompts (col. 27 lines 22-26)" over the telephone (audio apparatus). One having ordinary skill in the pertinent art would know that the digitized voice prompts stored in the database should be converted back to analog signals so that the voice prompts can be spoken over the telephone."

In response, Appellant assert that the preceding argument in "Response to Arguments", the Examiner's Answer does not address the aforementioned linkage requirements with respect to performance order and data coupling, and is thus not persuasive.

Furthermore, the assertion in the Examiner's Answer that "One having ordinary skill in the pertinent art would know that the digitized voice prompts stored in the database should be converted back to analog signals so that the voice prompts can be spoken over the telephone" is not relevant, because claim 9 is not being rejected over what is allegedly known by one having ordinary skill in the pertinent art. Rather, claim 9 is being rejected as allegedly anticipated by Osder under 35 U.S.C. § 102(b). Under 35 U.S.C. § 102(b), the Examiner's Answer must prove that Osder, and not one having ordinary skill in the pertinent art, explicitly or inherently teaches the features in claim 9, which Osder does not do.

Therefore, Osder does not anticipate claim 9

In addition, the "consisting of" language in the claimed first process limits the steps of the first process to the four recited steps of reading, passing, performing, and speaking. Appellant asserts that the Examiner's Answer has not demonstrated that Osder does not teach any other step than the recited four steps for the first process. In fact, it is nearly impossible to

determine the totality of steps for the first process in Osder, because Osder does not provide an organized teaching, such as in a flow chart, of the method steps for implementing Osder's invention. It is only with great difficulty in probing the Osder patent disclosure that enables method steps in Osder to be identified. Appellant notes that the Examiner's Answer has not even attempted to demonstrate that Osder's first process is limited to the four steps (reading, passing, performing, speaking) recited for the first process in claim 9.

For example, Osder's first process includes an "assembling" step that is not within the scope of the four steps (reading, passing, performing, speaking) recited for claim 9.

As indicated on page 4, line 22 - page 5, line 3 in the decision of the Board of Appeals and Interferences on February 21, 2007 (Appeal 2007-0338 for Application 09/870,223) (hereinafter, "Board Decision"), Osder's voice prompt that is spoken at runtime is assembled by inserting dynamic data (e.g., from Table 5 of Osder) into a template (e.g., from Table 3 of Osder) having static elements and missing portions, wherein the dynamic elements are inserted into the missing portions of the template to generate the final assembled voice prompt.

In particular, the Board Decision, page 5, lines 1-3 recites: "We recognize that Osder ultimately assembles a voice prompt at runtime by stringing together static and dynamic elements as Appellants indicate".

See also, Osder, col. 1, lines 48-57 which recites: "A prompt is composed of and defined by a sequence of static and dynamic elements. A static element denotes a fixed phrase, whereas a dynamic element provides a location in the prompt for variable data to be provided by the Network Application at run time. For example, in the prompt "you have <number> new messages", the phrases "you have" and "new messages" are static elements whereas <number> is

a dynamic element to be provided by the Network Application in accordance with the conditions at run time."

Osder does not teach omission of the preceding "assembling step" of assembling the runtime voice prompt by inserting the dynamic data into the template having the static elements and the missing data. Therefore, by being required to perform said "assembling step" which is not a step in the claimed first process of claim 9, Osder does not teach performing the claimed first process ***consisting of*** the four recited steps (reading, passing, performing, speaking).

Therefore, Osder does not anticipate claim 9

In "Response to Arguments", the Examiner's Answer, page 16, lines 5-12 argues: "In response, the instant claims only disclose the step of performing of the first process as "consisting of", not all of the limitations of the claims. The first process as outlined below allows for the processing of prompts having no dynamic data, such as a greeting. The interpretation of the claims, as a whole, allow for the processing of prompts having dynamic data, as well as, prompts not having dynamic data. M.P.E.P. 2111.03, details that when the phrase "consists of' appears in a clause of the body of a claim, rather than immediately following the preamble, it limits only the element set forth in that clause; other elements are not excluded from the claim as a whole. Therefore, the fact that assembly still occurs is moot."

In response, Appellant asserts that Osder's process comprising the "assembly" step is analogous to "the first process that generates a first complete message from the identified first database record and speaks the generated first complete message to the telephone caller", because the "assembly" step in Osder is performed after the"reading" step (i.e., "reading the

identified first database record)" and before the"speaking" step (i.e., "speaking, by the audio apparatus, the first complete message to the telephone caller").

Thus, the process in Osder that is analogous to the claimed first process includes the "assembly" step" and therefore does not ***consist of*** the four recited steps (reading, passing, performing, speaking).

Accordingly, Osder does not anticipate claim 9.

In "Response to Arguments", the Examiner's Answer, page 16, lines 12-23 further argues: "In addition, it appears that the appellant recited the term "contiguously" in place of the term "static" which had been previously recited in the claims. Some reasonable interpretations of the term "contiguously" or "static" can be applied as the specification does not define the exact scope of the terms. First, although the appellant uses the exemplary prompt "you have five new messages" found in Osder for his argument, it is noted that the prompt is only one example given in Osder's voice response system. Even in this exemplary prompt, "you," for example, can be considered as a first bit pattern existing in the first database record where each bit of "you" is stored contiguously prior to the conversion. The single prompt, "you" stored as contiguous bits in the database is read from the database, passed to be converted to analog signal so that "you" can be played. Therefore, "you" itself meets the requirements of the four steps: reading, passing, performing and speaking."

In response, Appellant asserts that "you" does not qualify as the generated first complete message that is generated from the identified first database record and is spoken in the step of "speaking, by the audio apparatus, the first complete message to the telephone caller", because "you" is a static element in Osder.. Appellant reiterates the Board Decision, page 5, lines 1-3

which recites: "We recognize that Osder ultimately assembles a voice prompt at runtime by stringing together static and dynamic elements as Appellants indicate".

Thus, Osder does not teach that speaking the static element "you" as the generated first complete message.

In "Response to Arguments", the Examiner's Answer, page 16, line 23 - page 17, line 15 further argues: "Second, it is noted that Osder states that every static and dynamic element of a SPIN application is recorded in the cache element table 80 (col. 10, lines 6-9; see, fig 5A) to play the whole prompt such as "you have five new messages" to the caller over the telephone. Accordingly, the message is considered to be played contiguously. Third, the instant specification states that: "The call flow instructions may specify that the first voice prompt heard by a telephone caller be a greeting. In the database 130 there could be a number of pre-recorded digitally encoded voice prompts that provide greetings in different languages, with different degrees of formality, spoken by male and female speakers and so forth (page 7)." Assuming that the contiguously stored bits refer to a greeting based on the specification, Osder also discloses the call flow of the Network Application directs to play the "user's recorded name or personal greeting (i.e. col. 12 lines 59-65)." As the instant invention uses the greeting as an example of the voice prompt, without further defining what the greeting consists of and does not even mention that a greeting is represented as contiguously stored bits, it is reasonable to interpret Osder's recorded personal greeting to be played is also a contiguously stored voice prompt."

In response, Appellant asserts that in Osder the dynamic elements are each contiguously stored bits in records of Table 3 of Osder, and the static elements are each contiguously stored bits in records of Table 5 of Osder. The Board Decision, page 5, lines 1-3 which recites: "We

recognize that Osder ultimately assembles a voice prompt at runtime by stringing together static and dynamic elements as Appellants indicate". Thus, Osder teaches an "assembly" step that strings together contiguously stored bits of dynamic elements and contiguously stored bits of static elements. Accordingly, the pertinent process in Osder includes the "assembly" step" and therefore does not ***consist of*** the four recited steps (reading, passing, performing, speaking).

Therefore, Osder does not anticipate claim 9

As a third example of why Osder does not anticipate claim 9, Osder does does teach a limitation of claim 9 resulting from antecedent basis considerations pertaining to "telephone caller". Specifically, the "telephone caller" in the speaking step of "speaking, by the audio apparatus, the first complete message to the telephone caller" is required by antecedent basis to be the same "telephone caller" as in the step of "receiving commands from a telephone caller".

As discussed *supra* in conjunction with the first example, the Examiner's Answer argues that Osder teaches the step of "receiving commands from a telephone caller" via the voice prompt recording and editing process described in Osder, col. 18, line 13 - col. 19, line 15. However, the description of the voice prompt recording and editing process in Osder, col. 18, line 13 - col. 19, line 15 is expressed in passive voice and does not identify the editing party providing the responses to queries in the form of Osder, FIG. 11. Thus, Osder does not teach that the editing party in the voice prompt recording and editing process is also the "telephone caller" in the speaking step.

Therefore, Osder does not anticipate claim 9.

Based on the preceding arguments, Appellant respectfully maintains that Osder does not anticipate claim 9, and that claim 9 is in condition for allowance.

Claim 18

Since claim 18 depends from claim 9 which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 18 is likewise not anticipated by Osder under 35 U.S.C. §102(b).

Claim 19

Since claim 19 depends from claim 9 which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 19 is likewise not anticipated by Osder under 35 U.S.C. §102(b).

Claim 20

Since claim 20 depends from claim 9 which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 20 is likewise not anticipated by Osder under 35 U.S.C. §102(b).

GROUND OF REJECTION 2

Claims 14, 15, 17 and 22-25 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Osder et al. (US Patent 5,493,606) hereinafter referred to as "Osder."

In addition with respect to claims 14-15, the decision of the Board of Appeals and Interferences (page 7, line 24 - page 8, line 7) on February 21, 2007 (Appeal 2007-0338 for Application 09/870,223) recites: "We will sustain the Examiner's rejection of claims 3-8 and 11-16. At the outset, we note that specifying the various attributes of voice prompts in these claims merely describes the content of the data stored in the voice prompt database. Because this data content does not further limit the claimed invention either functionally or structurally, it essentially constitutes non-functional descriptive material. Such non-functional descriptive material, however, does not patentably distinguish over prior art that otherwise renders the claims unpatentable. *See In re Ngai,* 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004)."

In light of the preceding analysis by the Board of Appeals and Interferences (Appeal 2007-0338 for Application 09/870,223), Appellant has restructured the language of claims 14-15 in a manner that the recited attributes of the voice prompts do not merely describe the content of the data stored in the voice prompt database, but actually recite the active method steps of speaking the first message. The language of claim 17 has been similarly restructured, as is the language of claims 22-25. Thus, the language of claims 14-15, 17, and 22-25 comprises functional material in the form of active method steps.

Appellant's analysis *infra* with respect to claims 14-15, 17, and 22-25 will make use of the following rules of law: A rejection of a claim on grounds of obviousness requires that all features of the claim are ***known*** in the prior art.

An attempt to show that it is obvious to combine elements to disclose the claimed invention starts with elements that are known in the prior art and then seeks to demonstrate that it obvious to combine the elements. *KSR Int'l Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) ("When it first established the requirement of demonstrating a teaching, suggestion, or motivation to combine **known elements** in order to show that the combination is obvious, the Court of Customs and Patent Appeals captured a helpful insight. See Application of Bergel, 292 F. 2d 955, 956-957 (1961)") (emphasis added).

Insight as to why all elements of a claim must be known to reject the claim on grounds of obvious is provided in *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) (reversing the Board's rejection of a claim based on alleged inherency under 35 U.S.C. 103 of a method to curb appetite, and stating: "[t]he inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessarily known. **Obviousness cannot be predicated on what is unknown**)."" (emphasis added)

In other words, demonstrating obviousness for modifying a relied-upon reference by subject matter not disclosed in the relied-upon reference comprises a first step and a second step. The first step is to provide legally acceptable evidence that the subject matter not disclosed in the relied-upon reference is known in the prior art. The second step is to provide analysis demonstrating that it is obvious to modify the relied-upon reference by incorporating into the relied-upon reference the subject matter that is known in the prior art but is not disclosed in the relied-upon reference.

Appellant will present arguments *infra* that the Examiner's Answer has repeatedly and consistently attempted to demonstrate obviousness by modifying the relied-upon reference of Osder by skipping the first step and arguing only the second step, which is legally impermissible under *KSR Int'l Co. v. Teleflex Inc.* More specifically, Appellant will present arguments *infra* demonstrating that the arguments in the Examiner's Answer with respect to various claims of claims 14-15, 17, and 22-25 has repeatedly rejected claims on grounds of obviousness without demonstrating that all elements of the claim are known in the prior art.

Appellant reiterates the following explanation for the preceding rule in *KSR Int'l Co. v. Teleflex Inc.* which limits the obviousness of modifying a relied-upon reference to incorporation of only ***known*** subject matter", namely the explanation that "Obviousness cannot be predicated on what is unknown" as recited in *In re Shetty*.

Claim 14

Since claim 14 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 14 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 14, Appellant respectfully contends that Osder does not disclose the feature: "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said music".

The Examiner's Answer argues that "Per claim 14: ... Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of music wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said music. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include music voice prompts as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences."

In response, Appellant notes that the Examiner's Answer has not cited any prior art reference that discloses the preceding feature of claim 14. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) ("Obviousness cannot be predicated on what is unknown"). Appellant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is ***unknown*** in the prior art.

The Examiner's Answer has not cited any prior art allegedly disclosing that it is known in the prior art to have a voice prompt consisting of music. Moreover, the Examiner's Answer has not cited any prior art allegedly disclosing that a preference for a voice prompt consisting of music is known in the prior art. Thus, the Examiner's Answer is arguing that it is obvious to modify Osder by including the ***unknown*** feature of using a voice prompt consisting of music, which is not legally permitted under *KSR Int'l Co. v. Teleflex Inc.* As *In re Shetty* states "Obviousness cannot be predicated on what is unknown". Therefore, Appellant respectfully contends that the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 14.

Accordingly, claim 14 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In "Response to Arguments", the Examiner's Answer, page 18, line 12 - page 19, line 1 argues: "Osder's prompt management system also provides the capability to create and modify the prompts and the elements of the prompts to be played (col. 4 lines 1-5; "speaks a different language or dialect," "prompts spoken by a man or by a woman," col. 28 lines 30-61). Osder's new prompt management system provides **"the ability to customize both the spoken voice** and grammatical organization of a Network Applications' prompts...from the call flow and programmatic logic of the Network Application (Osder, col. 27 lines 27-41)." Therefore, as Osder's system allows having different characteristics of voice prompts as in the instant invention, the modification of Osder to include different voice prompts such as music, beeps etc recited in the above claims is obvious for different personal preferences and purposes. Furthermore, the various vocal, dialect and linguistic characteristics of voice prompts such as beeps, music, spoken words etc are simply the data content stored in the database. Playing prompts that provide greetings spoken, for example, by a man or a woman, or music, beeps is not patentably distinct."

In response, Appellant asserts that Osder's disclosure of providing "the ability to customize both the spoken voice and grammatical organization of a Network Applications' prompts...from the call flow and programmatic logic of the Network Application" is not a disclosure in Oder of "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music" as claimed. Furthermore, the Examiner has presented any prior art allegedly disclosing "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music".

Therefore, since the Examiner's Answer has not demonstrated that it was known at the time of Appellant's invention that the voice prompt pertaining to the first bit pattern in the first database record consists of music, the Examiner's Answer has not satisfied the legal requirements for demonstrating obviousness as required by *KSR Int'l Co. v. Teleflex Inc.* In addition as stated in *In re Shetty*, "Obviousness cannot be predicated on what is unknown". Thus, the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 14.

In "Response to Arguments", the Examiner's Answer, page 19, lines 1-9 argues: "In addition, Appellant's specification acknowledges that it is known in the art for programmers to **"tailor** the vocal, dialect, or linguistic characteristics of voice prompts" in interactive voice response systems (see the background section of the Specification 2:3-11). This teaching strongly suggests that the voice prompts can be tailored to suit particular needs and preferences. This acknowlegment also directly contradicts the appellant's contension that the various charateristicsof the voice prompt such as music or beeps are "unknown in the prior art (brief 18-24)." In conclusion, these teachings amply support the obviousness to tailor Osder's voice prompts in themanner recited in claims for users with different preferences and purposes."

In response, Appellants note that the "Background" of Appellant's specification, page 2, lines 3-11 recites: "Such IVR systems may be employed by businesses with national or international scope. To improve customer relations in such situations, the business may want to tailor the vocal, dialect, or linguistic characteristics of voice prompts that are spoken by the IVR system according to local demographics or according to other management preferences. For example, a bank with a national clientele might prefer to greet callers from major metropolitan

financial centers with one degree of formality, whereas the bank might prefer to greet callers from rural areas or retirement communities with a different degree of formality... Tailoring the characteristics of IVR voice prompts requires, however, the skill of a specialized programmer."

Appellants assert that the preceding quote from the "Background" of Appellant's specification, page 2, lines 3-11 does not disclose knowledge in the prior art of "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of music".

Therefore, the preceding argument in the Examiner's Answer is not persuasive.

Claim 15

Since claim 15 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 15 is not unpatentable over Osder under 35 U.S.C. §103(a).

Claim 17

Since claim 17 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintain that claim 17 is not unpatentable over Osder under 35 U.S.C. §103(a).

In addition with respect to claim 14, Appellant respectfully contends that Osder does not disclose the feature: "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps, and wherein said speaking the first message comprises speaking the first message consisting of the digital-to-analog converted first bit pattern as said sequence of beeps".

The Examiner's Answer argues that "Per claim 17: ... Osder does not explicitly teach pertaining to the first bit pattern in the first database record consists of a sequence of beeps wherein said speaking the first complete message comprises speaking the first complete message consisting of the digital-to-analog converted first bit pattern as said a sequence of beeps. However, it would have been obvious for one having ordinary skill in the art of computer software development and configuration to include various voice prompts such as including beeps as callers may have different preferences and purposes. The modification would be obvious because one having ordinary skill in the art would be motivated to provide callers various voice prompt options for different preferences."

In response, Appellant notes that the Examiner's Answer has not cited any prior art reference that discloses the preceding feature of claim 17. As discussed *supra*, a claim cannot be rejected on a ground of obviousness if an element of the claim is unknown in the prior art. *In re Shetty*, 566 F.2d 81, 86, 195 USPQ 753, 756-57 (C.C.P.A. 1977) ("Obviousness cannot be predicated on what is unknown"). Appellant asserts that it is not obvious to modify Osder by incorporating into Osder a claimed feature that is ***unknown*** in the prior art.

The Examiner's Answer has not cited any prior art allegedly disclosing that it is known in the prior art to have a voice prompt consisting of a sequence of beeps. Moreover, the Examiner's Answer has not cited any prior art allegedly disclosing that a preference for a voice prompt consisting of a sequence of beeps is known in the prior art. Thus, the Examiner's Answer is arguing that it is obvious to modify Osder by including the ***unknown*** feature of using a voice prompt consisting of a sequence of beeps, which is not legally permitted under *KSR Int'l Co. v. Teleflex Inc.* As *In re Shetty* states "Obviousness cannot be predicated on what is

unknown". Therefore, Appellant respectfully contends that the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 17.

Accordingly, claim 17 is not unpatentable under 35 U.S.C. §103(a) over Osder.

In "Response to Arguments", the Examiner's Answer, page 18, line 12 - page 19, line 1 argues: "Osder's prompt management system also provides the capability to create and modify the prompts and the elements of the prompts to be played (col. 4 lines 1-5; "speaks a different language or dialect," "prompts spoken by a man or by a woman," col. 28 lines 30-61). Osder's new prompt management system provides **"the ability to customize both the spoken voice** and grammatical organization of a Network Applications' prompts...from the call flow and programmatic logic of the Network Application (Osder, col. 27 lines 27-41)." Therefore, as Osder's system allows having different characteristics of voice prompts as in the instant invention, the modification of Osder to include different voice prompts such as music, beeps etc recited in the above claims is obvious for different personal preferences and purposes. Furthermore, the various vocal, dialect and linguistic characteristics of voice prompts such as beeps, music, spoken words etc are simply the data content stored in the database. Playing prompts that provide greetings spoken, for example, by a man or a woman, or music, beeps is not patentably distinct."

In response, Appellant asserts that Osder's disclosure of providing "the ability to customize both the spoken voice and grammatical organization of a Network Applications' prompts...from the call flow and programmatic logic of the Network Application" is not a disclosure in Oder of "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps" as claimed. Furthermore, the Examiner's

Answerhas presented any prior art allegedly disclosing "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps".

Therefore, since the Examiner's Answer has not demonstrated that it was known at the time of Appellant's invention that the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps, the Examiner's Answer has not satisfied the legal requirements for demonstrating obviousness as required by *KSR Int'l Co. v. Teleflex Inc.* In addition as stated in *In re Shetty*, "Obviousness cannot be predicated on what is unknown". Thus, the Examiner's Answer has not established a *prima facie* case of obviousness in relation to claim 14.

In "Response to Arguments", the Examiner's Answer, page 19, lines 1-9 argues: "In addition, Appellant's specification acknowledges that it is known in the art for programmers to **"tailor** the vocal, dialect, or linguistic characteristics of voice prompts" in interactive voice response systems (see the background section of the Specification 2:3-11). This teaching strongly suggests that the voice prompts can be tailored to suit particular needs and preferences. This acknowlegment also directly contradicts the appellant's contension that the various charateristicsof the voice prompt such as music or beeps are "unknown in the prior art (brief 18-24)." In conclusion, these teachings amply support the obviousness to tailor Osder's voice prompts in themanner recited in claims for users with different preferences and purposes."

In response, Appellants note that the "Background" of Appellant's specification, page 2, lines 3-11 recites: "Such IVR systems may be employed by businesses with national or international scope. To improve customer relations in such situations, the business may want to tailor the vocal, dialect, or linguistic characteristics of voice prompts that are spoken by the IVR

system according to local demographics or according to other management preferences. For example, a bank with a national clientele might prefer to greet callers from major metropolitan financial centers with one degree of formality, whereas the bank might prefer to greet callers from rural areas or retirement communities with a different degree of formality... Tailoring the characteristics of IVR voice prompts requires, however, the skill of a specialized programmer."

Appellants assert that the preceding quote from the "Background" of Appellant's specification, page 2, lines 3-11 does not disclose knowledge in the prior art of "wherein the voice prompt pertaining to the first bit pattern in the first database record consists of a sequence of beeps".

Therefore, the preceding argument in the Examiner's Answeris not persuasive.

Claim 22

Since claim 22 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 22 is not unpatentable over Osder under 35 U.S.C. §103(a).

Claim 23

Since claim 23 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 23 is not unpatentable over Osder under 35 U.S.C. §103(a).

Claim 24

Since claim 24 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 24 is not unpatentable over Osder under 35 U.S.C. §103(a).

Claim 25

Since claim 25 depend from claim 9, which Appellant has argued *supra* to not be anticipated by Osder under 35 U.S.C. §102(b), Appellant maintains that claim 25 is not unpatentable over Osder under 35 U.S.C. §103(a).

SUMMARY

In summary, Appellants respectfully requests reversal of the November 12, 2008 Office Action rejection of claims 9, 14, 15, 17-20 and 22-25.

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